

REMARKS

In this response, Claims 7 and 25 has been canceled and Claims 1, 2, 12-14 have been amended. Thus, Claims 1-6 and 9-24 remain pending.

I. Rejections Under 35 U.S.C. § 102(b)

A. Claims 1-3, 5, 6, 9-11, 13-15, 17, and 22 over Dotolo.

The Examiner rejected Claims 1-3, 5, 6, 9-11, 13-15, 17, and 22 as being anticipated by Dotolo, U.S. Patent No. 4,379,168 ("Dotolo"). Reconsideration and withdrawal of the rejection is respectfully requested.

To anticipate a claim under 35 U.S.C. § 102(b), the reference must teach each and every element of the claim. Applicant respectfully submits that Dotolo does not teach each and every element of Claims 1-3, 5, 6, 9-11, 13-15, 17, and 22.

Independent Claims 1 and 13, as currently amended, is directed to a food-grade insecticidal composition comprising a specific emulsifying agent: "polyethoxylated castor oil." Claim 21, as originally provided, also recite a food-grade insecticidal composition which comprises "about 1% to about 25% by weight of a castor oil." Accordingly, Claims 1-3, 5, 6, 9-11, 13-15, 17, and 22 each require an insecticidal composition that comprises castor oil and further, that all of the ingredients in the insecticidal compositions are "food-grade" and non-toxic to humans. As disclosed in the specification, an ingredient or composition is

"food-grade" if it meets the U.S.F.D.A.'s G.R.A.S. (Generally Recognized as Safe) food grade standard. [Specification, at page 4].

In contrast, none of the pesticide compositions disclosed in Dotolo contain castor oil and are considered "food grade" and non-toxic to humans. For example, Dotolo discloses TRITON X-100 and IGEPAL CO-630 as surfactants or emulsifiers for use in the insecticide compositions. As disclosed in specification, "the Kodak Laboratory Chemical Catalog No. 51 indicates that TRITON X-100, which is disclosed as an acceptable emulsifier in Dotolo, is irritating to the skin and eyes." [Specification, page 2.] IGEPAL CO-630 is also irritating to the skin and eyes, may be harmful if inhaled or swallowed, and is believed to be a carcinogen and reproductive hazard. Attached as Exhibit A hereto is a Material Safety Data Sheet ("MSDS") for IGEPAL CO-630 obtained from Sigma-Aldrich.

In view of the foregoing, Applicant respectfully submits that the § 102(b) rejections are overcome with respect to Claims 1-3, 5, 6, 9-11, 13-15, 17, and 22, as each of these claims require an insecticidal composition that comprises castor oil and ingredients which are "food-grade" and non-toxic to humans. As explained above, there is no corresponding disclosure in Dotolo for insecticidal compositions which contain castor oil or which are comprised entirely of food-grade and non-toxic ingredients.

B. Claims 1, 6, 13, and 20 over Liebman.

The Examiner rejected Claims 1, 6, 13, and 20 as being anticipated by Liebman, Canadian Patent Application No. 2,060,594 ("Liebman"). Reconsideration and withdrawal of the rejection is respectfully requested.

To anticipate a claim under 35 U.S.C. § 102(b), the reference must teach each and every element of the claim. Applicant respectfully submits that Liebman does not teach each and every element of Claims 1, 6, 13, and 20.

As Applicant explained above, each of Claims 1, 6, and 20 require that the insecticidal compositions contain castor oil and are "food grade" and non-toxic. As Examiner notes, there is no disclosure in Liebman to an insecticidal composition that contains castor oil. [Office Action, page 3.] Moreover, Liebman does not disclose--or even suggest the need for--a food grade composition or the use of all food-grade ingredients. Therefore, Liebman cannot anticipate the rejected claims.

In view of the foregoing, Applicant respectfully submits that the § 102(b) rejections are overcome with respect to Claims 1, 6, 13, and 20, as each of these claims require an insecticidal composition that contains castor oil and ingredients which are "food-grade" and non-toxic to humans. As explained above, there is no corresponding disclosure in Liebman for insecticidal compositions which contain castor oil or which are comprised entirely of food-grade and non-toxic ingredients.

II. Rejections Under 35 U.S.C. § 103

A. **Claims 4 and 16 in view of Dotolo.**

The Examiner rejected Claims 4 and 16 as being unpatentable over Dotolo as applied to Claims 1-3, 5, 6, 9-11, 13-15, 17, and 22 in the 102(b) rejection, as follows:

It would have been obvious to one having ordinary skill in the art to determine the optimum amount of preservative to include in the composition. One would have been motivated to do this in order to prevent the composition from becoming rancid.

(Office Action, at page 30). Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 4 and 16 depend from independent Claims 1 and 13, respectively. Claims 1 and 13 each require that insecticidal compositions contain castor oil and are "food-grade" and non-toxic to humans. Applicant submits that Claims 4 and 16 recite the same limitations described by Applicant with regards to Applicant's response to the above 35 U.S.C. § 102 rejection. These limitations are not anticipated nor suggested by Dotolo, and Applicant therefore submits that Claims 4 and 16 are allowable for the same reasons as discussed above.

Moreover, Claims 4 and 16 requires the use of "food grade" preservatives, which is neither disclosed nor suggested in Dotolo. For example, Dotolo discloses using the following preservatives in the compositions: BHL, IONOL, and BARDAC22.

None of these preservatives are believed to be "food grade" and non-toxic. Attached as Exhibit B hereto is a MSDS for BHL and IONOL obtained from Sigma-Aldrich. The MSDS indicates that BHL and IONOL are synonyms for a butylated hydroxytoluene, which is harmful if swallowed and irritating to the eyes, respiratory, and skin.

Applicant submits that independent Claims 1 and 13 recite the limitations described by Applicant with regards to Applicant's response to the above 35 U.S.C. § 102 rejection. These limitations are not anticipated nor suggested by Dotolo. Dependent Claims 4 and 16, by virtue of depending on independent Claims 1 and 13, respectively, also recite the same limitations. As Dotolo fails to teaches or suggests the limitations in independent Claim 1 and 13, as described by the Examiner, Applicant submits that dependent Claims 4 and 16 are allowable for the same reasons as discussed above.

In view of the foregoing discussion, Applicant submits that the § 103 rejections are overcome. Thus, Applicant respectfully requests that the § 103 rejections be withdrawn.

B. Claims 2, 3, 7, 9, 11, 12, 14, 15, 21, and 24 over Liebman in view of Snyder.

The Examiner has rejected Claims 2, 3, 7, 9, 11, 12, 14, 15, 21, and 24 as being unpatentable over Liebman as applied to Claims 1, 6, 13, and 20 in further view of Snyder, U.S. Patent No. 6,063,771, ("Snyder"). Reconsideration and withdrawal of the

rejection is respectfully requested.

First, Snyder is not prior art to the rejected claims. Snyder issued on May 16, 2000 and claims priority to a provisional application filed on July 2, 1998. The present application claims priority to Application No. 08/846,351, which was filed on April 30, 1997 ("the '351 App."). A copy of the '351 App. is attached as Exhibit C hereto for the Examiner's reference. Claims 2, 3, 7, 9, 11, 12, 14, 15, 21, and 24 are fully supported by the disclosure of the '351 App. As a result, Snyder is not prior art to them and should be withdrawn as a reference.

Second, the Examiner has not identified a motivation in the prior art for combining Snyder and Liebman. "When determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." In re Rouffet, 149 F.3d 1350, 1356 (Fed. Cir. 1998) (emphasis added) (citations omitted). The Examiner contends that one of ordinary skill "would have been motivated to do this to enhance the consistency of the lotion taught by Liebman." However, neither reference identifies consistency as a desirable property in such a lotion. While Snyder describes PEG-60 castor oil as an optional component in an anti-lice formulation, it does not describe it as providing enhanced consistency. Furthermore, unlike the present invention, neither reference recognizes the

need to provide a food-grade composition or the suitability a castor oil emulsifier for addressing that need.

The factual inquiry whether to combine references must be based on objective evidence of record. In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). In Sang-Su Lee the Federal Circuit reversed a Board of Patent Appeals and Intereferences finding of obviousness, holding that "[t]his factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority." Id. at 1343-1344. Because there is no support for the proposition that a need for consistency would have motivated one of ordinary skill in the art to combine Snyder and Liebman, the combination is improper, and the rejection should be withdrawn.

In view of the foregoing discussion, Applicant submits that the § 103 rejections are overcome. Thus, Applicant respectfully requests that the § 103 rejections be withdrawn.

C. Claims 1, 2, 6, 7, 9, 11-15, 17-19, 21, 24, and 25 over Wilkins.

The Examiner also rejected Claims 1, 2, 6, 7, 9, 11-15, 17-19, 21, 24, and 25 as obvious over Wilkins Jr., U.S. Patent No. 5,951,992 ("Wilkins"). Examiner states that Wilkins teaches a method of applying a composition comprising 2-10% D-limonene, 1-10% emulsifier, and 80-96% water to crop or plants to control fire ant infestation. However, Examiner also states that Wilkins does not teach the invention comprising the claimed

amounts/ranges of D-limonene, emulsifying agent, and hydrophilic solvent and the plants being rose bushes and ornamentals.

Reconsideration and withdrawal of the rejection is respectfully requested.

Wilkins teaches a method of applying a D-limonene composition to control fire ants. The only emulsifier disclosed in Wilkins is MAZCLEAN EP. As with Liebman, Wilkins fails to disclose a food-grade insecticidal composition that comprises castor oil. In addition, the Examiner has neither asserted nor presented any evidence suggesting that MAZCLEAN EP is non-toxic to humans. Attached as Exhibit D is a data sheet for MAZCLEAN EP, obtained from a BASF Corporate website. The data sheet indicates that MAZCLEAN EP is a "monocyclic terpene hydrocarbon." Because Wilkins neither discloses food-grade insecticidal compositions comprising castor oil, Wilkins does not disclose or render obvious the invention in Claims 1, 2, 6, 7, 9, 11-15, 21, 24, and 25.

Moreover, each of Claims 1, 2, 6, 7, 9, 11-15, 21, 24, and 25 are directed to food-grade insecticidal compositions comprising castor oil. Wilkins neither teaches nor suggests the use of castor oil in any of its compositions and therefore cannot render Claims 1, 2, 6, 7, 9, 11-15, 21, 24, and 25 obvious.

In view of the foregoing discussion, Applicant submits that the § 103 rejections are overcome. Thus, Applicant respectfully requests that the § 103 rejections be withdrawn.

III. DOUBLE PATENTING

A. Statutory Type Double Patenting.

Claim 25 was provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 30 of copending Application No. 10/692,512. This rejection appears to be in error because Application No. 10/692,512 is this instant application. Notwithstanding this, a rejection of Claim 25 is now moot because Applicant has canceled Claim 25 without prejudice to pursuing it in Application No. 10/235,450 in response to the Examiner's nonstatutory type double patenting rejection below.

B. Nonstatutory Type Double Patenting.

Claim 25 was rejected on the ground of statutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,784,211. Applicant has canceled Claim 25 without prejudice to pursuing it in Application No. 10/235,450. Thus, the rejection is moot and withdrawal is respectfully requested.

Claims 1-6 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 31-34, 41-48 of copending Application No. 10/235,450. Applicant files herewith a terminal disclaimer, pursuant to 37 C.F.R. 1.130(b) and 1.321(c), to overcome this rejection. Thus, Application respectfully requests that the

rejection be withdrawn.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance.

Respectfully submitted,

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